

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF PUERTO RICO**

**LIBERTY MUTUAL INSURANCE
COMPANY**

CIVIL No.: 3:20-cv-1423

Plaintiff,

v.;

**LIBERTY CABLEVISION OF PUERTO
RICO LLC; and LIBERTY
COMMUNICATIONS OF PUERTO RICO
LLC**

**COMPLAINT FOR TRADEMARK
INFRINGEMENT AND DILUTION;
INJUNCTIVE RELIEF AND DAMAGES**

Defendants.

COMPLAINT

TO THE HONORABLE COURT:

COMES NOW, Plaintiff, Liberty Mutual Insurance Company (hereinafter, “Liberty Mutual”), through the undersigned attorneys, and respectfully states and prays as follows:

I. COMPLAINT

Liberty Mutual, by and through its attorneys, Ferraiuoli, LLC, files this Complaint against Liberty Cablevision of Puerto Rico LLC (“Liberty Cablevision”) and Liberty Communications of Puerto Rico LLC (“Liberty Communications”) (both Liberty Cablevision and Liberty Communications hereinafter collectively, the “Defendants”), for trademark dilution under federal law and trademark infringement under federal and state law, and hereby avers as follows:

II. NATURE OF THE CASE

1. Liberty Mutual’s claims arise out of Defendants’ willful dilution and trademark infringement under the Lanham Act, 15 U.S.C. § 1051 et seq., and the Puerto Rico Trademark Act, P.R. Laws Ann. Tit. 10, § 223 et seq., of its prior and longstanding family of valid, subsisting, and

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famous U.S. trademark registrations for LIBERTY (collectively, the “Liberty Marks”), which Liberty Mutual has used since as early as February 19, 1919, in connection with the provision of insurance-related goods and services.

2. Despite being well aware of the Liberty Marks, which are famous throughout the United States, including Puerto Rico, and have been in continued use for over a century, and the strong goodwill associated therewith, Defendants, a Delaware limited liability company and a Puerto Rico limited liability company, with principal place of business in Puerto Rico, began using and continue to use the LIBERTY SMART PROTECT mark in connection with the offering of insurance goods and services; namely, extended warranties for goods and services (the “Liberty Protect Mark”).
3. Defendants’ use of the Liberty Protect Mark is likely to dilute and cause confusion with the famous and distinctive Liberty Marks.
4. Upon information and belief, Defendants have used and continue to use the Liberty Protect Mark on their Web site and potentially other advertising and promotional materials in order to identify and build goodwill in their brand. Such use is harmful to both Liberty Mutual and the consuming public.
5. As described thoroughly below, under the Liberty Marks, Liberty Mutual offers and provides insurance services to over ten (10) million consumers in the United States and even more worldwide. Defendants’ use of the Liberty Protect Mark is likely to dilute the strong and famous Liberty Marks, which form a unique source identifier within the field of insurance services. Because Defendants are using a mark that is very similar to the Liberty Marks, in connection with products and services affiliated with insurance and warranty services,

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Defendants' use is likely to dilute the famous Liberty Marks, thus severely harming Liberty Mutual.

6. Defendants' use is also likely to cause consumer confusion, mistake, and/or deception as to the source, origin, or association of their products and services. This is particularly true given the strength of the Liberty Marks, the Defendants' use of the similar Liberty Protect Mark, and the fact that the parties offer products and services affiliated with warranty and other insurance goods and services within the same territory. In light of the strong goodwill that the Liberty Marks have obtained throughout the United States, including Puerto Rico, consumers are likely to believe that Defendants are, among other things, affiliated with Liberty Mutual due to their use of the Liberty Protect Mark when, in fact, that is not the case.
7. For these reasons, and as explained further below, Liberty Mutual seeks preliminary and permanent injunctive relief to stop Defendants' diluting and infringing activity, as well as monetary damages to compensate Liberty Mutual for the harm suffered as a result of Defendants' use of the Liberty Protect Mark in connection with the promotion and offering of insurance and warranty services in violation of Liberty Mutual's prior rights in its famous Liberty Marks.

III. THE PARTIES

8. Liberty Mutual is a Massachusetts stock insurance company with a principal place of business at 175 Berkeley Street, Boston, Massachusetts 02116.
9. Upon information and belief, Liberty Cablevision is a Delaware limited liability company authorized to do business in Puerto Rico with a designated office address at Luquillo Industrial Park, Road 992 Km. 0.2. Luquillo, PR 00773.

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10. Upon information and belief, Liberty Communications is a Puerto Rico limited liability company with a principal place of business at 279 Ave. Ponce de León Esq. Roosevelt, San Juan, PR 00918 and it is an affiliate of Liberty Cablevision.

IV. SUBJECT MATTER JURISDICTION AND VENUE

11. This action arises under the federal Lanham Act, 15 U.S.C.A. §§ 1051 et seq. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C.A. §§ 1114, 1116, 1121 and 28 U.S.C.A. §§ 1331 (federal question), 1338(a) (trademark infringement), and 1367(a) (supplemental jurisdiction).

12. Venue is proper in this district pursuant to 28 U.S.C.A. § 1391 because, among other reasons, Defendants' principal places of business are located in Puerto Rico and because the wrongdoing giving rise to these claims, was and is committed in Puerto Rico.

V. ALLEGATIONS COMMON TO ALL COUNTS

The Fame of the Liberty Marks

13. Liberty Mutual is a Fortune 500¹ insurance services company with over one hundred and thirty-three point six billion dollars (\$133.6 billion) in assets and over forty-three point two billion dollars (\$43.2 billion) in global revenue in 2019. The National Association of Insurance Commissioners gave Liberty Mutual a market share rank of five (5) in the United States and reported that Liberty Mutual received thirty-four point eight billion dollars (\$34.8 billion) in direct premiums written for businesses in the United States in 2019.

14. Liberty Mutual has been ranked in the top five (5) insurance companies in the United States by the National Association of Insurance Commissioners for more than ten (10) years.

¹ Ranked 77th based on its reported revenue in 2019.

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15. Liberty Mutual's clients range from private consumers to commercial entities who look to Liberty Mutual to satisfy their insurance needs. Liberty Mutual has insured tens of millions of private consumers and commercial entities in the United States in the past ten (10) years.

16. Liberty Mutual is the owner of numerous U.S. federal trademark registrations for the Liberty Marks, covering a broad spectrum of Class 36 insurance services.

17. Specifically, Liberty Mutual is the owner of over one hundred (100) trademark registrations in the United States Patent and Trademark Office ("USPTO"). A sample of some of the registrations under the Liberty Marks' family are the following:

Mark / Registration No.	Class/Services
LIBERTY MUTUAL Reg. No. 2734195	I.C. 036- Insurance services, namely, insurance underwriting and administration of insurance dealing with accident, liability, and property insurance and reinsurance, including the following kinds of insurance--fire and other property, general liability, workmen's compensation, automobile, aircraft, disability, fidelity, surety, burglary, forgery, water damage, marine and ocean marine; insurance brokerage services; property and casualty loss management and claims adjustment services; insurance claims administration and adjustment services provided as part of insured or self-insurance programs; appraisal, consulting, and analytical service in the fields of medical, disability, property and casualty insurance claims; insurance information, management, and consultancy services; and provision of the above-listed insurance services on-line from a computer database or via the internet.
LIBERTY SPECIALTY MARKETS Reg. No. 4993762	I.C. 036- Insurance services and reinsurance, namely, underwriting insurance and reinsurance of all kinds, insurance and reinsurance brokerage services, consultancy services in the field of insurance and reinsurance, loss management and claims adjustment services for all types of insurance and reinsurance; insurance and reinsurance claims administration and adjustment services provided as a part of insured or self-insurance programs; real and personal property appraisal,

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Mark / Registration No.	Class/Services
	consulting, and analytical services, namely, providing data-driven analysis to demonstrate the soundness of insurance claims decisions and claims forecasting for all types of insurance and reinsurance claims; insurance and reinsurance underwriting services for all types of insurance and reinsurance; insurance and reinsurance claims administrative services; insurance and reinsurance consultancy services; providing information on insurance and reinsurance matters; insurance and reinsurance premium rate quotation services; providing an online computer database for tracking, monitoring, and generating reports on information and statistics about insurance and reinsurance claims and reimbursement; provision of the above-listed services on-line from a computer database or via the internet; financial sponsorship of sporting and cultural events; providing websites in the fields of insurance and reinsurance information; providing management agency services in respect of syndicates.
LIBERTY INTERNATIONAL UNDERWRITERS Reg. No. 2992030	I.C. 036- Insurance services, namely, insurance underwriting and administration of insurance in the fields of accident, liability, life, health, property, fire and other property, general liability, workmen's compensation, automobile, aircraft, disability, fidelity, surety, burglary, forgery, water damage, marine and ocean marine insurance; reinsurance services; pension services; annuity services; insurance brokerage services; property and casualty loss management and claims adjustment services; insurance claims administration and adjustment services provided as part of insured or self-insurance programs; appraisal, consulting, and analytical services in the fields of medical, disability, property and casualty, life and health insurance claims; insurance information, management, and consultancy services; services in the fields of financial analysis, evaluation, information, management and consultancy; mutual fund services; mutual fund management services; investment counseling, consulting services and investment advice; brokerage, consulting, counseling, administration, management and underwriting services in the fields of securities, mutual funds, annuities and combinations thereof, financing services; fiscal assessments and valuations and provision of the above-listed insurance

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Mark / Registration No.	Class/Services
	and financial services on-line from a computer database or via the internet
LIBERTY MUTUAL CUSTOMER ADVANTAGE Reg. No. 5246739	I.C. 035- Offering a program of discounts, coverages, financial incentives, services, and other benefits to insurance customers.
 <p>Liberty Global Transaction Solutions</p> <p>Reg. No. 6009021</p>	I.C. 036- Insurance underwriting services for all types of insurance, including, mergers and acquisitions, representations and warranties, warranty and indemnity, tax liability, tax credit, and contingent risk; insurance consultancy; insurance information services; insurance administration.
<p>LIBERTY MUTUAL DEDUCTIBLE FUND Reg. No. 4679496</p>	I.C. 036- Insurance services, namely, underwriting, issuing and administration of property and automobile insurance; insurance administration; providing insurance information; insurance consulting services.
 <p>Liberty International Underwriters</p> <p>Reg. No. 2891140</p>	I.C. 036- Insurance services, namely insurance underwriting, brokerage and reinsurance services in the fields of property and casualty, general liability, accident, aviation, marine, engineering, automobile and aircraft damage and liability, disability, life, burglary, forgery, environmental impairment liability, energy, workers' compensation, internet liability and specialty casualty, namely, directors and officers liability, professional liability, errors and omissions, financial institutional bonds, professional malpractice, fiduciary and pension trust liability and employment practical liability; insurance loss management and adjustment services; claims administration and adjustment services provided as part of insured or self insured programs; appraisal, consulting, and statistical services in the field of insurance claims; insurance information, management, and consultancy services; and provision of the above-listed insurance services on-line from a computer database or via the internet.
LIBERTY MUTUAL INNOVATION Reg. No. 5363001	I.C. 035- Advisory services in the fields of business management, marketing, consumer research, and executive mentoring.

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Mark / Registration No.	Class/Services
	I.C. 036- Insurance and financial advisory services; research and development services in connection with insurance policies, underwriting and administration.
LIBERTY MUTUAL REALTIME REVIEW Reg. No. 5370585	I.C. 036- Insurance claims processing, assessing and administration, all in the field of automotive, casualty and property insurance.
 Reg. No. 5237367	I.C. 018- Sports bags, luggage tags, back packs, shoe bags for travel, luggage, luggage straps. I.C. 025- Shirts, jackets, hats, caps, pants. I.C. 028- Covers for golf clubs, head covers for golf clubs, golf club bags, golf accessory bags, driving practice mats, golf balls. I.C. 041- Organizing of golf tournaments; entertainment in the nature of golf tournaments; providing news and information on the sport of golf.
 Reg. No. 4989010	I.C. 036- Insurance services and reinsurance, namely, underwriting insurance and reinsurance of all kinds, insurance and reinsurance brokerage services, consultancy services in the field of insurance and reinsurance, loss management and claims adjustment services for all types of insurance and reinsurance; insurance and reinsurance claims administration and adjustment services provided as a part of insured or self-insurance programs; real and personal property appraisal, consulting, and analytical services, namely, providing data-driven analysis to demonstrate the soundness of insurance claims decisions and claims forecasting for all types of insurance and reinsurance claims; insurance and reinsurance underwriting services for all types of insurance and reinsurance; insurance and reinsurance claims administrative services; insurance and reinsurance consultancy services; providing information on insurance and reinsurance matters; insurance and reinsurance premium rate quotation services; providing an online computer database for tracking, monitoring, and generating reports on information and statistics about insurance and reinsurance claims and reimbursement; provision of the above-listed services on-line from a computer database or via the internet; financial

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Mark / Registration No.	Class/Services
	sponsorship of sporting and cultural events; providing websites in the fields of insurance and reinsurance information; providing management agency services in respect of syndicates.
 Liberty Mutual INSURANCE Reg. No. 4256502	I.C. 036- Insurance underwriting services for all types of insurance; insurance consultancy; insurance information services; insurance administration
 Liberty Mutual INSURANCE Reg. No. 1405249	I.C. 036- Underwriting and administration of insurance dealing with accident, liability and property insurance and reinsurance, including the following kinds of insurance: fire and other property, general liability, workers compensation, automobile and aircraft damage and liability, disability fidelity, surety, burglary, forgery and water damage
 Liberty Mutual REINSURANCE Reg. No. 4365441	I.C. 036- Insurance underwriting services for all types of insurance; insurance consultancy; insurance information services; insurance administration
 Liberty Mutual SURETY Reg. No. 4362057	I.C. 036- Insurance underwriting services for all types of insurance; insurance consultancy; insurance information services; insurance administration

18. The registrations set forth in **Exhibit A**, Reg. Nos. 2734195 and 1405249, serve as evidence of Liberty Mutual's long standing and continuous presence in United States commerce and constitute *prima facie* evidence of Liberty Mutual's ownership of and exclusive rights to use

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the Liberty Marks in connection with the services recited in the registrations and any services confusingly similar thereto.

19. Liberty Mutual's goods and services are provided around the globe. Specifically, Liberty Mutual and its subsidiaries, affiliates, and/or partners' presence expands to countries such as, but not limited to, Canada, Ecuador, Mexico, Bermuda, Brazil, Colombia, Perú, Chile, Belgium, France, Germany, Ireland, Italy, Luxembourg, Netherlands, Portugal, Spain, Switzerland, United Kingdom, Australia, China, Hong Kong, India, Malaysia, Singapore, Thailand, United Arab Emirates, and Vietnam.

20. Within the Commonwealth of Puerto Rico, policy holders have continuously purchased goods and services under the Liberty Marks since, at least, 2006.

21. Liberty Mutual has offered, sold, and continues to offer and sell its goods and services through its local branch in Puerto Rico, located in 304 Ponce de Leon Avenue, Suite 903, San Juan, Puerto Rico, 00918.

22. Liberty Mutual's sales in direct written premium in Puerto Rico, for 2019, amounted to fifty-two million eight hundred twenty-two thousand six hundred twenty-three dollars (\$52,822,623.00).

23. Within the past ten (10) years, from 2009 through 2019, Liberty Mutual's revenues in Puerto Rico, as a result of sales in direct written premium, have amounted to two hundred thirty-four million four hundred sixty-thousand seven-hundred fifty-five dollars (\$234,460,755.00).

Liberty Mutual's Advertising and Media Presence

24. Liberty Mutual has a daily presence in the insurance industry, including frequent appearances in major news outlets and events, which has furthered the worldwide reputation of the Liberty

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Marks as a single authority and source of insurance goods and services across a variety of industry sectors.

25. Liberty Mutual has expended significant time, money, and effort promoting and marketing the Liberty Marks, and goods and services provided thereunder, through substantial and ongoing business activities across all major industry sectors in the United States and around the globe.
26. In advertising alone, Liberty Mutual invested over six hundred forty million dollars (\$640,000,000.00) in 2019 in the United States alone. Over the past ten (10) years, from 2009 through 2019, Liberty invested over four point seven billion dollars (\$4.7 billion) in advertising expenses in the United States.
27. The vast nature and extent of use of the Liberty Marks has rendered the Liberty Marks a powerful symbol of, and a single authoritative source for, insurance underwriting in the United States and Puerto Rico.
28. The Liberty Marks are well-known and famous and have attained significant consumer recognition in the marketplace. Liberty Mutual's fame and the strength of the Liberty Marks are regularly recognized by their inclusion in various "best places to work" lists, including those of Fortune, People, and Forbes.
29. Liberty Mutual has also been widely recognized by multiple industry peers and business entities. Some of the recognitions received by Liberty Mutual throughout the years include, but are not limited to: (1) Best Employers for Women List by Forbes magazine from 2018 through 2020; (2) Ranked No. 73 on Fortune Magazine's 2019 Best Workplaces for Diversity; (3) Certified as a 2019 Great Place to Work by Great Place to Work U.S.; (4) Ranked No. 33 by People Magazine in 2019's Companies that Care; and (5) Rated 100% on Human Rights Campaign Foundation's 2020 Scorecard on LGBTQ Workplace Equality, among many others.

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30. Within the insurance industry, Liberty Mutual has been receiving accolades for over a decade.

The awards and recognitions include, but are not limited to, the following: (1) Ranked the most satisfied independent commercial insurance agents by J.D. Power's 2018 and 2019 U.S. Independent Insurance Agent Satisfaction Study, developed with the Independent Insurance Agents & Brokers of America; (2) Awarded the Social TV Awards' Best Sports Social TV Award for Liberty Mutual's Olympics RISE advertising campaign in 2014; (3) Awarded the Online Marketing Media and Advertising Award ("OMMA Award") for Integrated Online Campaign in Financial Services for the Olympics' RISE advertising campaign in 2014; (4) Awarded the Insurance Marketing & Communications Association- Sammy Award in 2008 and 2012; (5) Awarded, in 2018, the Communicator Awards for (a) Campaign-Branding, (b) Corporate Identity Campaign- Identity Program Campaign, and (c) Content Marketing- E-mail Marketing; and (6) Awarded, in 2018, the Content Marketing Awards for (a) Best Content Marketing Program (strategy driven), (b) Best Content Driven Website, (c) Content Marketing ROI/Measurement Program, and (d) Best Content Strategy.

31. Liberty Mutual has been featured twice, in 2014 and 2020, as a clue in the New York Times' crossword puzzle.

32. Liberty Mutual's presence has reached millions of consumers. As a mere example, Liberty Mutual is the Official Property and Casualty and Life Insurance Partner of the United States Olympic and Paralympic Teams since 2014. Liberty Mutual was also an official sponsor of the Women's and Men's U.S. Soccer Team from 2015 through 2018. Moreover, Liberty Mutual is a partner of the Statue of Liberty-Ellis Island Foundation and provided its support in the creation of the Statue of Liberty Museum, which opened in 2019. Finally, Liberty Mutual has

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sponsored one of television's most-watched history series, American Experience, on PBS since 1997.

33. Liberty Mutual's reach in social media platforms is also widespread. Liberty Mutual's Facebook page has over one million nine-hundred followers (1,900,000). In YouTube, two of Liberty Mutual's commercials (published through Liberty Mutual's YouTube account) have over forty million views (40,000,000)². These commercials both contain Liberty Mutual's iconic, distinctive, and unique "Liberty, Liberty, Liberty, Liberty" jingle.

34. Given Liberty Mutual's vast presence in the insurance industry, consumers are likely to mistakenly believe that Defendants are somehow affiliated with or sponsored by Liberty Mutual, or that Defendants' services are authorized by Liberty Mutual.

35. As a result of the long and extensive use of the Liberty Marks, and the significant sales, promotion, advertising, third-party acclaim, and commercial success thereunder, the Liberty Marks have achieved such widespread public exposure and recognition that they are highly distinctive and have been well-known and famous among the general consuming public of the United States for many years.

VI. DEFENDANTS' DILUTION AND INFRINGEMENT OF THE FAMOUS LIBERTY MARKS

36. Upon information and belief, Liberty Cablevision was registered as a Delaware limited liability company on December 27, 2011.

37. Upon information and belief, Liberty Communications was registered as a Puerto Rico limited liability company on May 24, 2005.

² <https://www.youtube.com/c/libertymutual/videos?view=0&sort=p&flow=grid>

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38. Upon information and belief, Defendants have been publishing, through their website, the offering and sale of warranty goods and services through the following link: <https://www.libertypr.com/smartprotect>. *See, Exhibit B*, a true and accurate copy of a screen capture from Defendants' web page. Such services are regulated as insurance and are related to Liberty Mutual's services offered through the Liberty Marks.
39. On July 16, 2018, Defendants filed for registration, in the Puerto Rico Trademark Office ("PRTO"), the Liberty Protect Mark in International Class 036 for "[i]nsurance services, namely, underwriting, issuance and administration of consumer electronic **products insurance**; Providing **extended warranties** on consumer electronic products; **Extended warranty services**, namely, service contracts" (Application No. 227782-36-1) (emphasis ours). *See, Exhibit C*, Liberty Protect Mark Application in PRTO.
40. Upon information and belief, and pursuant to Defendants' trademark application of the Liberty Protect Mark in the PRTO, its date of first use was April 17, 2018.
41. Liberty Mutual's use of the Liberty Marks in Puerto Rico's commerce predates the date of first use alleged by Defendants through the Liberty Protect Mark's application. Specifically, Liberty Mutual's use of the Liberty Marks predates the Liberty Protect Mark by over ninety (90) years. Therefore, Liberty Mutual's rights have priority.
42. Defendants' use of the Liberty Protect Mark attempts to trade off of the goodwill and fame associated with Liberty Mutual and the Liberty Marks which has been long established in the insurance industry for over a century and is likely to dilute the famous Liberty Marks.
43. Defendants' use of the Liberty Protect Mark particularly in the similar, recognizable configuration, with the prominent "Liberty" term, is likely to cause confusion, mistake, and/or deception as to the source or origin of Defendants' products and services and commercial

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activities, and is likely to falsely suggest a sponsorship, connection, license, and/or association of Defendants and/or their products and services with Liberty Mutual and/or its products and services.

44. Defendants' services under the Liberty Protect Mark are for the sale of insurance products (warranties) and so are highly related to the insurance and warranty services provided under the Liberty Marks.

45. Thus, Defendants' use of the Liberty Protect Mark is likely to dilute the distinctiveness of the famous Liberty Marks.

46. Defendants' use of the Liberty Protect Mark is also detrimental to the public's interest in being free from confusion as to the source, sponsorship, and/or affiliation of Defendants' products and services.

47. Liberty Mutual has not consented to Defendants' use of the Liberty Protect Mark for goods and/or services under International Class 036.

48. Defendants' use of the Liberty Protect Mark has damaged and irreparably injured, and, if permitted to continue, will further damage and irreparably injure, Liberty Mutual, the Liberty Marks, and Liberty Mutual's reputation and goodwill associated with the Liberty Marks.

49. Upon information and belief, Defendants were aware of Liberty Mutual's prior rights in and to the famous Liberty Marks before selecting and using the Liberty Protect Mark in connection with its warranty services. Thus, Defendants have acted willfully with respect to Liberty Mutual's rights.

COUNT I

(Trademark Infringement under the Lanham Act, 15 U.S.C. § 1114(1))

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50. Liberty Mutual incorporates the allegations set forth in the preceding paragraphs as if fully set forth herein.

51. Without Liberty Mutual's consent, Defendants have used, continue to use, and are likely to use in commerce the Liberty Protect Mark, as described above, in connection with activities that are directed to warranty and insurance services, which is likely to cause confusion, or to cause mistake, or to deceive consumers, in violation of Section 32(1)(a) of the Lanham Act, 15 U.S.C.A. § 1114(1)(a).

52. Upon information and belief, Defendants' actions, described above, have at all times relevant to this action been willful.

53. As a direct and proximate result of the actions of Defendants alleged above, Liberty Mutual has been damaged and will continue to be damaged.

COUNT II

(Trademark Dilution under the Federal Anti-Dilution Act, 15 U.S.C. § 1125(c))

54. Liberty Mutual incorporates the allegations set forth in the preceding paragraphs as if fully set forth herein.

55. Based, at least, on the distinctiveness of the Liberty Marks, the duration and extent of use of the Liberty Marks, which has been in use for over a hundred (100) years, the duration and extent of advertising featuring the Liberty Marks, the geographic area in which Liberty Mutual's goods and services have been offered and advertised under the Liberty Marks, the nature of the trade channels used to market Liberty Mutual's services under the Liberty Marks compared to the trade channels through which Defendants sell, intend to sell, and are likely to sell their products and services, the degree of public recognition of the Liberty Marks, and Liberty Mutual's numerous federal registrations for the Liberty Marks, the Liberty Marks have

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become famous, as that term is used in Section 43(c) of the Lanham Act, and have been famous for many years. Thus, Defendants began using the Liberty Protect Mark in connection with warranty services after Liberty Mutual's Liberty Marks were famous.

56. Defendants' actions described above, all occurring after the Liberty Marks became famous, are likely to cause dilution of the famous Liberty Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C.A. § 1125(c).

57. Upon information and belief, Defendants' actions described above have at all times relevant to this action been willful.

58. As a direct and proximate result of the actions of Defendants alleged above, Liberty Mutual has been damaged and will continue to be damaged.

COUNT III

(Infringement under Puerto Rico Trademark Act, P.R. Laws Ann. Tit. 10, § 223w)

59. Liberty Mutual incorporates the allegations set forth in the preceding paragraphs as it fully set forth herein.

60. By virtue of having used and continuing to use the Liberty Marks, Liberty Mutual has acquired common law rights in the trademarks.

61. Defendants' use of the Liberty Protect Mark infringed Liberty Mutual's common law rights in the Liberty Marks and is likely to cause confusion, mistake, or deception among consumers, who will believe that Defendants' services originate, from or are affiliated with or endorsed by Liberty Mutual, when, in fact, they are not.

62. As the direct and proximate result of Defendants' infringement of Liberty Mutual's trademark rights under Puerto Rico and other common law, Liberty Mutual has suffered and will continue to suffer irreparable injury to its business, reputation, and goodwill.

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PRAYER FOR RELIEF

WHEREFORE, Liberty Mutual prays that this Court enter judgment in its favor on each and every claim for relief set forth above and award it relief, including, but not limited to, the following:

- a. An Order declaring that Defendants' use of the Liberty Protect Mark infringes the Liberty Marks, and is likely to dilute the Liberty Marks under federal law, as detailed above;
- b. Temporary, preliminary, and permanent injunctions enjoining Defendants and their employees, officers, directors, principals, subsidiaries, parents, affiliates, related companies, agents, and all persons in active concert or participation with any of them:
 1. From using the Liberty Protect Mark and any designs, logos, or marks that are confusingly similar to or likely to dilute the Liberty Marks, in connection with warranty and/or insurance services; and
 2. From representing by any means whatsoever, directly or indirectly, that Defendants, any products or services offered by Defendants, or any activities undertaken by Defendants, are associated or connected in any way with Liberty Mutual;
- c. An Order directing Defendants and their employees, officers, directors, principals, subsidiaries, parents, affiliates, related companies, agents, and all persons in active concert or participation with any of them to destroy or permanently alter all Web sites, signage, posters, displays, brochures, catalogs, newsletters, manuals, forms, stationery, television commercials, videos, advertising and promotional materials and items, and any other materials and things that

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bear or display the Liberty Protect Mark and/or any other designs, logos, or marks that are confusingly similar to or likely to dilute the Liberty Marks;

d. An order directing Defendants and their employees, officers, directors, principals, subsidiaries, parents, affiliates, related companies, agents, and all persons in active concert or participation with any of them to cancel all placements of any advertising in any media or format bearing or displaying the Liberty Protect Mark and/or any other designs, logos, or marks that are confusingly similar to or likely to dilute the Liberty Marks;

e. An Order directing Defendants to file with this Court and serve on Liberty Mutual's attorneys, thirty (30) days after the date of entry of any injunction, a report in writing and under oath setting forth in detail the manner and form in which they have complied with the Court's injunction;

f. An Order requiring Defendants to account for and pay to Liberty Mutual any and all profits arising from the foregoing acts of infringement and dilution, and increasing such profits for payment to Liberty Mutual in accordance with 15 U.S.C.A. § 1117 and other applicable laws;

g. An Order requiring Defendants to pay Liberty Mutual damages in an amount as yet undetermined caused by the foregoing acts of infringement and dilution, and trebling such damages for payment to Liberty Mutual in accordance with 15 U.S.C.A. § 1117 and other applicable laws;

h. An Order requiring Defendants to pay Liberty Mutual's costs and attorney's fees in this action pursuant to 15 U.S.C.A. § 1117, and other applicable laws.

i. An Order that Defendants have violated the Puerto Rico Trademarks Act, P.R. Laws Ann. Tit. 10, § 223w, and that requires Defendants to pay Liberty Mutual for its damages.

j. Other relief as the Court may deem appropriate.

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RESPECTFULLY SUBMITTED.

In San Juan, Puerto Rico, this 14th day of August 2020.

Ferraiuoli LLC
Looking Forward

P.O. Box 195168
San Juan, P.R. 00919-5168
Tel.: 787.766.7000
Fax: 787.766.7001

By: /s/**Maristella Collazo-Soto**
Maristella Collazo-Soto
USDC-PR No. 228606
Email: mcollazo@ferraiuoli.com

/s/**Cristina Arenas-Solís**
Cristina Arenas-Solís
USDC-PR No. 223511
Email: carenas@ferraiuoli.com

/s/**Giancarlo Colberg-Ferrer**
Giancarlo Colberg-Ferrer
USDC-PR No. 306914
Email: gcolberg@ferraiuoli.com